

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Group Art Unit: 3622
YAMASHITA)
Serial No.: 08/598,578) Examiner: D. Fenstermacher
Filed: February 12, 1996)
For: BRAKE LEVER STROKE)
ADJUSTING MECHANISM)
)

DECLARATION OF JOHN C. ROBBINS IN SUPPORT OF
PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Assistant Commissioner of Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

1. I, John C. Robbins, am the agent of record in the above referenced patent application and have been registered to practice before the U.S. Patent and Trademark Office (USPTO) since December 1990. My Registration No. is 34,706.
2. I am a patent agent working for the law firm of Shinjyu Office Of Patent Attorneys, Ohtemae Century Building, 5-13, Katamachi 1-chome, Miyakojima-ku, Osaka 534-0025. I have been employed at Shinjyu Office of Patent Attorneys since April, 1994.
3. Sometime in the period between January, 1994 and April, 1994. I was informed by a representative at the Office Of Enrollment and Discipline at the USPTO that practicing from abroad was permitted by the USPTO. I was also informed at that time that all correspondence from the USPTO is sent by surface mail. In the case where correspondence is sent to Japan, sea mail is used. Sea mail takes approximately 3 months to reach Japan from the U.S.
4. In March, 1994, detailed arrangements were made between Shinjyu Office Of Patent Attorneys and the law firm of Roylance, Abrams, Berdo & Goodman, whose offices are located at 1225 Connecticut Ave., N.W. , Washington, D.C. 20036-2680. Part of the

arrangements specified that Shinjyu Office of Patent Attorneys in Osaka, Japan is permitted to include the address of Roylance, Abrams, Berdo & Goodman on patent applications and related papers filed with the USPTO. Therefore, the correspondence address for the above identified patent application is the address of Roylance, Abrams, Berdo & Goodman.

5. All correspondence from the USPTO relating to a patent application filed by Shinjyu Office Of Patent Attorneys, when received by Roylance, Abrams, Berdo & Goodman is forwarded to Shinjyu Office Of Patent Attorneys in Osaka Japan. John Holmes, who is a partner at the law firm of Roylance, Abrams, Berdo & Goodman supervises the forwarding of official correspondence from Roylance, Abrams, Berdo & Goodman to Shinjyu Office Of Patent Attorneys in Osaka Japan.

6. There are several secretaries at Shinjyu Office Of Patent Attorneys in Osaka Japan under my direct supervision who handle all correspondence relating to patent applications filed at the USPTO. These secretaries are knowledgeable with regard to U.S. patent practice and are aware of the importance of accurate docketing. The secretaries are diligent with regard to entering information into Shinyu's docketing system.

7. Each morning, all correspondence (including both mail and facsimile transmissions) is reviewed by the secretaries under my supervision and any correspondence that includes an Office Action or an Official Paper in a patent application filed at the USPTO, is set aside for docketing purposes. Shortly thereafter, docketing information is entered into Shinjyu's computerized docketing system. The file and correspondence (including the Official Papers) are brought to me along with a printout of the entered docketing information for proofing and review.

8. Shinjyu Office Of Patent Attorneys maintains a detailed docket of all patent applications filed on behalf of our clients. At the time of the abandonment of the above identified application, our docket system was maintained on a Windows based computer using docketing database software. The docket includes information relating to filings in Japan, Europe, Asian countries, and the United States. An updated docket is printed each week and

is provided to each of the professionals in our office. A redacted photocopy of two such weekly dockets are provided as EXHIBITS A and B. EXHIBIT A is page three from the week of December 18, 1997 and EXHIBIT B is page two from the week of August 20, 1998.

9. On May 1, 1998, Shinjyu Office Of Patent Attorneys established a business relationship with Shinjyu Global IP Counselors located at 1233 20th Street, NW, Suite 700, Washington DC, 20036. Mr. Todd Guise is an employee of Shinjyu Global IP Counselors and regularly travels to the USPTO on behalf of Shinjyu Office Of Patent Attorneys.

10. On November 18, 1997, the undersigned filed a RESPONSE AFTER FINAL in order to place the above identified application into condition for allowance. The response was facsimile transmitted directly to Art Unit 3502 (now Art Unit 3622).

11. The undersigned observed in Shinjyu's docketing system during August 1998 (see EXHIBIT B), that no Official Papers had been received with respect the above identified application in more than six months. Therefore, the undersigned filed a STATUS INQUIRY on August 10, 1998 to learn the status of the above identified application. A photocopy of the STATUS INQUIRY accompanies this declaration as EXHIBIT C.

12. On September 3, 1998 John Holmes of Roylance, Abrams, Berdo & Goodman facsimile transmitted a NOTICE OF ABANDONMENT to Shinjyu Office Of Patent Attorneys. The NOTICE OF ABANDONMENT had a mailing date of August 17, 1998.

13. Immediately after receiving the NOTICE OF ABANDONMENT, the undersigned contacted Mr. Todd Guise of Shinjyu Global IP Counselors with instructions to inspect the file history of the above identified application and make photocopies of any and all papers relating to a NOTICE OF ALLOWANCE. A POWER TO INSPECT AND COPY document signed by the undersigned was given to Mr. Todd Guise for presentation to the US Patent and Trademark Office. The POWER TO INSPECT AND COPY document should be in the file history.

14. Mr. Todd Guise first contacted the US Patent and Trademark Office with a request to inspect the file history on September 9, 1998, as is shown in the accompanying EXHIBIT D.

15. Mr. Todd Guise was repeatedly denied access to the file history by the USPTO. Finally, on October 20, 1998, Mr. Todd Guise submitted a REQUEST FOR OFFICIAL SEARCH, EXHIBIT E, with the USPTO in order to locate the file history.

16. On November 13, 1998, Mr. Todd Guise was finally allowed to inspect the file history and made photocopies of the NOTICE OF ALLOWANCE. The file history indicated that the NOTICE OF ALLOWANCE was mailed on November 25, 1997.

17. The undersigned thereafter reviewed the all of the docket printouts and backups maintained in our offices for the period from November 25, 1997 through August 1998. The review showed that no Notice Of Allowance was ever received during the period mentioned above. The redacted photocopy of our docket provided in EXHIBIT A from December 18, 1997, shows that no docket entry was made after submission of the RESPONSE AFTER FINAL on November 11, 1997. The undersigned further searched the files maintained in our office, including continuation and division applications claiming priority to the above identified application, and found no evidence that a Notice Of Allowance was ever received in the above identified application.

18. The undersigned further contacted Mr. John Holmes regarding the abandonment of the above identified application, as is detailed in Mr. John Holmes accompanying declaration.

19. In view of the above factual information, no Notice Of Allowance was ever received by our office nor was notification of such a document ever received by our office. The undersigned was not aware of any problems with the application until receipt of the NOTICE OF ABANDONMENT in September 1998.

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I further state that all statements made herein of my own knowledge are true and that all statements made herein on information and belief to be true, and I further understand that willful false statements and the like are punishable by fine or imprisonment, or both under 18 USC § 1001, and may jeopardize the validity of this application or any patent issuing therefrom.

Respectfully submitted,

Date: Jan. 12, 1999



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Docket No.: F0101SN-US